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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,034	03/23/2005	Brian D Wichner	9812-003	8989
20575 7590 08/18/2008 MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204				
EXAMINER				
ALIE, GHASSEM				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
08/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,034

**Applicant(s)**

WICHNER, BRIAN D

**Examiner**

GHASSEM ALIE

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05/05/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 11, 14, 19 and 24-37 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 14, 19 and 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 24-26 and 33-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election without traverse of Group I (1-2, 4, 11, 14, 19 and 24-30) and Subgroup ID (claims 26 and 26) in the reply filed on 05/05/08 is acknowledged.
2. Claims 2, 4, 14, 19 and 27-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05/05/08.

***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. See pages 1-5 and 9 in the instant specification.

***Specification***

4. The amendment filed on 12/14/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: New Figs. 2A-2C and their related description in the specification have not been originally disclosed in the original disclosure. The original disclosure does not disclose the specific shape and dimension of the U-shaped blade shown in Fig. 2A and the linear blade shown in new Fig. 2B; and the shape and size of the serrated blade as shown in Fig. 2C. It should be noted that the objection to the drawings

for not showing the serrated cutting edge set forth in claims 4 and 36 will be applied when the new Figs. 2A-2C are cancelled.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 11, 25, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tervola (5,070,563) in view of Genda (1,971,814). Regarding claim 1, Tervola teaches a safety cutting tool including a sliding guide 9 configured for placement on a finger; a blade support 10 affixed to the sliding guide 9, the blade support having a blade member, wherein the blade support and the sliding guide together define a blade support opening 11 having an entrance height to establish a predetermined maximum size of an object that is capable of contacting the blade member. See Figs. 1-3 in Tervola. Tervola also teaches that the blade includes two or more opposing sharpened cutting edges facing one another. It should be noted that the sharpened inner region 12 in Tervola includes sharpened edges which are located on both top and bottom surfaces of the gap 11. See col. 2, lines 50-67 and Fig. 4 in Tervola. In this case, the sharpened region 12 includes two opposing sharpened cutting edges facing one another and forming a V-shaped cutting edge. Tervola does not explicitly teach that the sliding guide is configured to be placed on a user's forearm. However, the use of a cutting member that is placed on a finger or a user's forearm is well known in the art such as

taught by Genda. Genda teaches a cutting device including a sliding guide positioned either on a user's finger or on a user's forearm. Genda also teaches means 6 for removeably attaching the sliding guide to the user's forearm. See Figs. 1-2 in Genda. It would have been obvious to a person of ordinary skill in the art to position Tervola's sliding guide on a user's forearm, as taught by Genda, in order to free the finger of the user and cut the desired material with the cutter that is placed on the forearm of the user.

Regarding claim 11, Tervola teaches everything noted above including that the sliding guide and the blade support constitute a single part.

Regarding claim 25, Tervola teaches everything noted above including that the predetermined maximum size appears to be 1 centimeter. In addition, it would have been an obvious matter of design choice to select the height of the entrance according to a specific height for a particular object, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955)*.

Regarding claim 33, Tervola, as modified above, teaches everything noted including that the blade support is affixed to the distal end of the sliding guide, wherein the bottom surface of the sliding guide faces the user's forearm, and wherein the top surface of the sliding guide is exposed to be capable of receiving the object from a special region vertically above the sliding guide. It should be noted that when the sliding guide is connected to a strap 6 in Genda; the sliding guide is not in a form of a ring and includes a distal end. See Figs. 1-2 in Genda.

Regarding claims 34-35, Tervola teaches everything noted above including that the object is capable of contacting the two or more opposing sharpened cutting edges by smoothly sliding across a portion of the top of the sliding guide.

7. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tervola in view of Genda, as applied in claim 35, and in further view of Burns (1,435,514).

Regarding claim 36, Tervola, as modified above, teaches everything noted above except that the cutting edges are serrated. However, the use of serrated and smooth cutting edges is well known in cutting devices. Burns teaches a pair of scissors that has serrated cutting edges. It would have been obvious to a person of ordinary skill in the art to provide Tervola's cutting device as modified by Genda, with serrated cutting edges, as taught by Burns, in order to improve the cutting action of the cutting edges by creating a friction between the edges of the object to be cut and the cutting edges of the cutting device.

Regarding claim 37, Tervola teaches everything noted above including that the length of sliding guide appears to be between 10 to 15 centimeters. In addition, it would have been an obvious matter of design choice to select the length of the sliding guide as specific above, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

8. Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tervola in view of Genda and in further view of Stoltz (2,352,921). Regarding claim 24, Tervola teaches substantially the claimed invention including a sliding guide 9 configured for placement on a finger; a blade support 10 affixed to the sliding guide 9, the blade support

having a blade member, wherein the blade support and the sliding guide together define a blade support opening 11 having an entrance height to establish a predetermined maximum size of an object that is capable of contacting the blade member. See Figs. 1-3 in Tervola. Tervola also teaches that the blade includes two or more opposing sharpened cutting edges facing one another. It should be noted that the sharpened inner region 12 in Tervola includes sharpened edges which are located on both top and bottom surfaces of the gap 11. In this case, the sharpened region 12 includes two opposing sharpened cutting edges facing one another and forming a V-shaped cutting edge. Tervola does not explicitly teach that the sliding guide is configured to be placed on a user's forearm. However, the use of a cutting member that is placed on a finger or a user's forearm is well known in the art such as taught by Genda. Genda teaches a cutting device including a sliding guide positioned either on a user's finger or on a user's forearm. Genda also teaches means 6 for removeably attaching the sliding guide to the user's forearm. See Figs. 1-2 in Genda. It would have been obvious to a person of ordinary skill in the art to position Tervola's sliding guide on a user's forearm, as taught by Genda, in order to free the finger of the user and cut the desired material with the cutter that is placed on the forearm of the user.

Tervola, as modified by Genda, does not explicitly teach that the sliding guide has a long axis of symmetry and the top of the sliding guide is convex and the bottom of the sliding guide is concave. However, Stoltz teaches a sliding guide 10 having a long axis of symmetry and the top of the sliding guide is convex and the bottom of the sliding guide is concave. See Figs. 1-3 in Stoltz. It would have been obvious to a person of ordinary skill in the art to form the sliding guide of Tervola's cutting device, as modified by Genda, with a long axis of

symmetry, a convex top, and concave bottom, as taught by Stoltz, in order to facilitate placement of the cutting device on a user's forearm.

Regarding claim 26, Tervola teaches everything noted above including that the predetermined maximum size appears to be 1 centimeter. In addition, it would have been an obvious matter of design choice to select the height of the entrance according to a specific height for a particular object, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

To the degree that it could be argued that Tervola does not explicitly teach that the blade includes two cutting edges facing one another the rejection below is applied.

9. Claims 1, 11, 25, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tervola (5,070,563) in view of Genda (1,971,814) and in further view of Tidwell (6,108,913). Regarding claim 1, Tervola teaches a safety cutting tool including a sliding guide 9 configured for placement on a finger; a blade support 10 affixed to the sliding guide 9, the blade support having a blade member, wherein the blade support and the sliding guide together define a blade support opening 11 having an entrance height to establish a predetermined maximum size of an object that is capable of contacting the blade member. See Figs. 1-3 in Tervola. Tervola does not explicitly teach that the sliding guide is configured to be placed on a user's forearm. However, the use of a cutting member that is placed on a finger or a user's forearm is well known in the art such as taught by Genda. Genda teaches a cutting device including a sliding guide positioned either on a user's finger or on a user's forearm. Gebda also teaches means 6 for removeably attaching the sliding guide to the user's



forearm. See Figs. 1-2 in Genda. It would have been obvious to a person of ordinary skill in the art to position Tervola's siding guide on a user's forearm, as taught by Genda, in order to free the finger of the user and cut the desired material with the cutter that is placed on the forearm of the user.

Tervola, as modified above, does not explicitly teach that the blade includes two or more opposing sharpened cutting edges facing one another. However, the use of a blade having V-shaped cutting edges facing one another is well known in the art such as taught by Tidwell. Tidwell teaches a cutting device having a blade having two cutting edges 110, 112 that facing one another. See Fig. 1 in Tidwell. It would have been obvious to a person of ordinary skill in the art to form the blade of Tervola's cutting device, as modified by Genda, with two cutting edges facing one another, in order to cut the object by lower and upper cutting edges.

Regarding claim 11, Tervola teaches everything noted above including that the sliding guide and the blade support constitute a single part.

Regarding claim 25, Tervola teaches everything noted above including that the predetermined maximum size appears to be 1 centimeter. In addition, it would have been an obvious matter of design choice to select the height of the entrance according to a specific height for a particular object, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955)*.

Regarding claim 33, Tervola, as modified above, teaches everything noted including that the blade support is affixed to the distal end of the sliding guide, wherein the bottom

surface of the sliding guide faces the user's forearm, and wherein the top surface of the sliding guide is exposed to be capable of receiving the object from a special region vertically above the sliding guide. It should be noted that when the sliding guide is connected to a strap 6 in Genda, it is not in a form of a ring and includes a distal end. See Figs. 1-2 in Genda.

Regarding claims 34-35, Tervola teaches everything noted above including that the object is capable of contacting the two or more opposing sharpened cutting edges by smoothly sliding across a portion of the top of the sliding guide.

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Regarding claim 37, Tervola teaches everything noted above including that the length of sliding guide appears to be between 10 to 15 centimeters. In addition, it would have been an obvious matter of design choice to select the length of the sliding guide as specific above, since such a modification would have involved a mere change in the size of a component. A

change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

11. Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tervola in view of Genda and Tidwell and in further view of Stoltz (2,352,921). Regarding claim 24, Tervola teaches substantially the claimed invention including a sliding guide 9 configured for placement on a finger; a blade support 10 affixed to the sliding guide 9, the blade support having a blade member, wherein the blade support and the sliding guide together define a blade support opening 11 having an entrance height to establish a predetermined maximum size of an object that is capable of contacting the blade member. See Figs. 1-3 in Tervola. Tervola does not explicitly teach that the sliding guide is configured to be placed on a user's forearm. However, the use of a cutting member that is placed on a finger or a user's forearm is well known in the art such as taught by Genda. Genda teaches a cutting device including a sliding guide positioned either on a user's finger or on a user's forearm. Genda also teaches means 6 for removeably attaching the sliding guide to the user's forearm. See Figs. 1-2 in Genda. It would have been obvious to a person of ordinary skill in the art to position Tervola's sliding guide on a user's forearm, as taught by Genda, in order to free the finger of the user and cut the desired material with the cutter that is placed on the forearm of the user.

Tervola, as modified Genda, does not explicitly teach that the blade includes two or more opposing sharpened cutting edges facing one another. However, the use of a blade having V-shaped cutting edges facing one another is well known in the art such as taught by Tidwell. Tidwell teaches a cutting device having a blade having two cutting edges 110, 112

that facing one another. See Fig. 1 in Tidwell. It would have been obvious to a person of ordinary skill in the art to form the blade of Tervola's cutting device, as modified by Genda, with two cutting edges facing one another, in order to cut the object by lower and upper cutting edges.

Tervola, as modified by Genda and Tidwell, does not explicitly teach that the sliding guide has a long axis of symmetry and the top of the sliding guide is convex and the bottom of the sliding guide is concave. However, Stoltz teaches a sliding guide 10 having a long axis of symmetry and the top of the sliding guide is convex and the bottom of the sliding guide is concave. See Figs. 1-3 in Stoltz. It would have been obvious to a person of ordinary skill in the art to form the sliding guide of Tervola's cutting device, as modified by Genda and Tidwell, with a long axis of symmetry, a convex top and concave bottom, as taught by Stoltz, in order to facilitate placement of the cutting device on a user's forearm.

Regarding claim 26, Tervola teaches everything noted above including that the predetermined maximum size appears to be 1 centimeter. In addition, it would have been an obvious matter of design choice to select the height of the entrance according to a specific height for a particular object, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955)*.

#### ***Response to Amendment***

12. Applicant's arguments with respect to claims 1-2, 4, 11, 19 and 24 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

Art Unit: 3724

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GA

/Ghassem Alic/

Primary Examiner, Art Unit 3724

August 14, 2008